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OFFICE OF PETITIONS

In re Application of :
Claudine Bruck et al. :
Application No. 10/687,060 : DECISION ON PETITION
Filed: October 16, 2003 :
Attorney Docket No. B45110C1 :
Title: FUSION PROTEINS :
COMPRISING HIV-1 TAT AND/OR NEF :
PROTEINS :

This is a decision on the petition under 37 C.F.R. §1.53, filed November 1, 2004, requesting that Figure 2 be accorded a filing date of October 16, 2003, as part of the original disclosure.

The petition is **GRANTED-IN-PART**.

On October 16, 2003, the above-identified application was filed. On September 13, 2004, the Office of Initial Patent Examination (OIPE) mailed a "Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures" (Notice), stating that the application had been accorded a filing date of October 16, 2003, and advising applicant both that a sequence listing would be required and that Figure 2 appeared to have been omitted.

In response, on November 1, 2004, applicants filed the present petition. The petition is further accompanied by the petition fee, and an explanation that Figure 2 was included on filing, but was not labeled. Petitioner has further included what appears to be a sequence listing.

Upon review of the record, Figure 2 has been located among the application papers, and it is obvious that it was included upon filing, and was simply unlabeled as a result of the applicant's filing error. Therefore, the application, including Figure 2, was complete on filing and entitled to a filing date of October 16, 2003. However, the Notice mailed on September 13, 2004 was correct in stating that Figure 2 appeared to have been omitted. Therefore, the Notice was properly mailed and will not be withdrawn.

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

Petitioner has set forth that the figure was constructively included on filing via incorporation by reference. However, since the figure was actually included, there is no need to seek entry via an incorporation by reference.

A preliminary amendment adding a label to the unlabeled figure should be filed before first action on the merits. Any such amendment will, of course, be reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

The application file is being returned to the Office of Initial Patent Examination for further processing with a filing date of October 16, 2003, using the application papers filed on that date.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

¹ See MPEP 608.02(h) and 608.04.